

REMARKS/ARGUMENTS

This amendment is submitted in response to the Office Action dated September 22, 2006. Reconsideration and allowance is requested.

Claims 35-38, 42-45, and 55-60 remain in this application.

Claims 1-34 and 48-54 have been canceled by the Applicant as a result of an earlier restriction requirement. Claims 39-41 and 46-47 have been withdrawn by the Examiner in this office action as being drawn to a non-elected species 7.

Claims 55-60 are new claims added by this amendment. Support for new claims 55-60 can be found throughout the originally filed specification and drawings including paragraphs [0083] and [0084].

Claim Objection

In the Office Action, claims 35-47 were objected to because the term "the top surface" in claims 35 and 42 lack an antecedent basis and the term "EMI" in claims 35 and 42 should be spelled out. Claims 35 and 42 have been amended to spell out the term "electromagnetic interference (EMI)" and to provide an antecedent bases for "the top surface." In light of these amendments and remarks the Applicant believes that the objection has been overcome.

Claim Rejection under 35 USC 102

In the Office Action, claims 35-36, 38, 42-43 and 45 were rejected under 35 USC 102(e), as being anticipated by Ogawa et al. (US 6,683,245). "Under 35 USC § 102, anticipation requires that each and every element of the claimed invention be disclosed in a prior art reference..." *Akzo v N.V. v. U.S. Int'l Trade Comm'n*, 808 F.2d 1471, 1 USPQ2d 1241 (Fed. Cir. 1986) cert. denied, 482 U.S. 909 (1987).

The Examiner asserted that,

Regarding claims 35 and 42, Ogawa et al., figure 3 shows an electronic device comprising: a printed circuit board (11) comprising an electronic component (6) and a grounding portion;

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an EMI shield (18a) comprising an upper surface that including one or more features, a plurality of sidewalls that extend from the upper surface, and a flange extend in a direction substantially parallel to a surface of the printed circuit board; and a housing (10a) of the electronic device configured to enclose the printed circuit board and the EMI shield; wherein the features on the upper [sic] surface interact with an inner surface of the housing so as to compress the flange against the grounding portion on the printed circuit board.

The Applicant respectfully traverses. Ogawa does not teach each and every element of claims 35 and 42. For example, Ogawa does not teach "an electromagnetic interference (EMI) shield comprising a top surface that includes one or more features." Although the Examiner did not specifically point to the "features" in Ogawa, it appears that the only "features" Ogawa teaches are ribs 17a and 17b. However, Ogawa's ribs 17a and 17b are located on the housing 10 and not on the EMI shield 18a, as claimed. Therefore, Ogawa does not teach this element of the claim. Additionally, Ogawa does not teach "wherein the features on the top surface interact with an inner surface of the housing so as to compress the flange of the EMI shield against the grounding portion on the printed circuit board," as claimed. Although Ogawa's FIG. 3 appears to show that the EMI shield 18a might contact both the ground pattern 14a and the housing 10a, Ogawa clearly does not mention that the housing compresses the flange of the EMI shield against the grounding portion on the printed circuit board, as claimed. Additionally, the Applicant points out that just because two objects are in contact there is not necessarily a compression between the two as claimed. Thus, the Applicant does not believe that each and every element of claims 35 and 42 are taught by Ogawa. Additionally, since claims 36, 38, 43 and 45 depend from claims 35 and 42, each and every element of these claims is also not taught by Ogawa.

Therefore the Applicant believes that claims 35-36, 38, 42-43 and 45 are not anticipated by Ogawa under *Akzo* and respectfully requests that the Examiner reconsider his rejection.

Claim Rejection under 35 USC 103

In the Office Action, the Examiner rejected claims 37 and 44 under 35 USC 103(a), as being unpatentable over Ogawa et al. (6,683,245) in view of Seidler (6,870,091). The Applicant respectfully traverses.

In order to establish *prima facie* obviousness three basic criteria must be met. First, there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references (or references when combined) must teach or suggest all of the claimed limitations. The teachings or suggestions to make the claimed invention and the reasonable expectation of success must be found in the prior art and not based on Applicant's disclosure. See *In re Vaeck* 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) and MPEP 2143. The Applicant respectfully submits that the Examiner has not satisfied all three criteria outlined in MPEP 2143.

In rejecting claims 47 and 44 the Examiner acknowledged that Ogawa does not disclose "semi-circular protrusions that extend toward the inner surface of the housing." However the Examiner rejected the claims by arguing that,

Seidler, figure 7 shows a shield (1) having a raised portion (5) with a semi-circular protrusion. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ogawa et al to have the shield with the raised portion, as taught by Seidler, in order to have the stronger contact between the inner surface of the housing and the EMI.

From reading Seidler it appears that the only reason why Seidler uses a raised portion 5 is to provide a mechanism to apply a force to the shield so that it can be bent and removed from the bottom portion 11 mounted to the circuit board 23. This is clearly illustrated in Seidler's FIGs. 5 and 5A. One skilled in the art reading either Ogawa or Seidler would have no motivation to combine these teachings because Seidler's raised portion (5) would not work

with Ogawa's shield. Ogawa's shield 18a and 18b are conductive coatings which are coated directly onto the housing 10. Specifically, Ogawa describes in column 3 lines 33-39:

The conductive coatings 18a and 18b are formed by coating of an agent. For example, as an agent for the conductive coating 18a, Shintron E-3063 or E-3073 of Shinto Chemitron may be used. A thickness of the coating can be approximately 30 .mu.m, for example. Besides the nickel base shield coating agent of the example, a copper base agent may also be used.

It would be very difficult if not impossible to form Seidler's raised protrusions on upper surface of Ogawa's coatings 18a and 18b when Ogawa's coating is coated directly onto the inside of the housing. Seidler's raised portions are clearly located on the portions of the shield that would be adjacent to Ogawa's housing. Since Ogawa's shield directly contacts the housing, it is not possible to combine Seidler's raised portions with Ogawa's EMI shield and housing because Ogawa deposits his shield directly onto the housing. Moreover, the Applicant believes that impermissible hindsight has been used to reject the claims. It appears that elements of different references have been mixed and matched to reject the claims without proper motivation. Without the benefit of the Applicant's teaching it is unlikely that one skilled in the art would have made the substitution especially since the two teachings are incompatible. The Applicant believes that there is no motivation to combine the teachings of Seidler with the teachings of Ogawa to make the claimed invention. Therefore the Applicant believes that claims 37 and 44 are not obvious under *In re Vaeck* and respectfully requests that the Examiner reconsider his rejection.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

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PATENT

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,


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